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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,409	05/31/2002	Christian Kirsten	H 4388 PCT/US	3267
423	7590	02/15/2005	EXAMINER	
HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			HARAN, JOHN T	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/069,409

Applicant(s)

KIRSTEN ET AL.

Examiner

John T. Haran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-30 is/are pending in the application.
- 4a) Of the above claim(s) 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/31/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 12-28 in the reply filed on 1/10/05 is acknowledged. The traversal is on the ground(s) that there is no lack of unity. This is not found persuasive because the only common technical feature is applying a hotmelt adhesive to a substrate and such is notoriously well known and conventional, as shown for example in Kilgore et al (U.S. Patent 6,497,786). Accordingly this common technical feature is not special and claims 12 and 29 lack unity.

Applicant argues that both claims 12 and 29 require bonding two substrates with a hotmelt adhesive, however it is noted that such is not required of claim 29 and furthermore such is notoriously well known and conventional. Applicant also argues that both claims 12 and 29 require a microwave activatable primer, however such is only required of claim 12. In addition, Applicant argues that both claims 12 and 29 require the hotmelt adhesive to have nanoscale particles, however such is only required of claim 29.

The requirement is still deemed proper and is therefore made FINAL.

***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 5/31/02 has been considered by the examiner.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kilgore et al (U.S. Patent 6,497,786) in view of Hurter et al (U.S. Patent 4,948,450).

Kilgore et al is directed to a method for bonding substrates together, such as parts of a shoe, using a hotmelt adhesive wherein two substrates, such as outsoles and midsoles of a shoe, are provided a primer and a hotmelt adhesive are placed between the two substrates, the assembly is pressed together, the assembly is then exposed to microwaves which causes the hotmelt adhesive to melt and then the assembly is allowed to cool for the hotmelt to solidify (Column 3, lines 6-44 and Column 10, lines 38-45).

Kilgore et al teaches that the adhesive may inherently be microwave susceptible and heat in response to exposure to microwaves or may have microwave susceptible material or dopant added to it, which increases the susceptibility of the adhesive to microwaves (Column 11, lines 23-55). Kilgore et al is silent towards the primer being microwave activatable. However, one skilled in the art would have readily appreciated that all substances, including primers, have some level of microwave susceptibility and that it can be increased by adding microwave susceptible material to the substance. One skilled in the art would have readily recognized that having the primer microwave

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activatable in addition to or in place of the hotmelt adhesive. One skilled in the art would have readily understood that having both the primer and hotmelt microwave activatable would increase the efficiency of the process by speeding up the melting because more heat would be generated in a quicker time to melt the adhesive. In addition having the primer microwave activatable instead of the adhesive is an obvious alternate expedient that achieves the same end result of creating heat to melt the adhesive to adhere the two substrates. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a microwave activatable primer in the method of Kilgore et al for the reasons noted above.

Kilgore et al is also silent towards the exact sequence of applying the adhesive and primer to the substrates, however it is well known and conventional in the adhesive bonding art when bonding two substrates together to apply a primer to one substrate, an adhesive to the other substrate, and to then press the substrates together with the adhesive and primer therebetween, as shown for example in Hurter et al (See Figure 1). One skilled in the art would have readily appreciated using conventional method for applying a microwave activatable primer and a hotmelt adhesive to two substrates to be bonded together. It would have been obvious to apply the primer to one substrate and the hotmelt to another substrate and then press the substrates together with the adhesive and primer therebetween in the method of Kilgore et al, as is conventional in the art as evidenced by Hurter et al.

Regarding claims 12-13, Kilgore et al teaches it is known to have a porous substrate such as leather (Column 7, line 44).

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Regarding claims 15-16, Kilgore et al teaches it is known to use two different microwave active additives that differ in property (Column 11, lines 39-55).

Regarding claim 17, as noted above one skilled in the art would have readily appreciated that having a microwave activatable primer in place of a microwave activatable hotmelt is an obvious alternate expedient.

Regarding claims 18-21, the claimed application manners are all well known and conventional manners for applying hotmelt adhesives and it would have been obvious to use any of them in the method of Kilgore et al, as modified above.

Regarding claim 22, Kilgore et al teaches that the microwave exposure 3.5 to 10 GHz.

Regarding claims 23 and 24, one skilled in the art would have readily appreciated that the amount and duration of the pressure application would depend upon a variety of factors such as the materials worked upon and would have been within the skill of the ordinary artisan to determine.

Regarding claim 25, Kilgore et al is directed to using microwave activation without heating the substrates (Column 5, lines 62-65).

Regarding claims 26 and 27, Kilgore et al teaches continuing pressure after the microwave exposure until the hot melt is cooled (Column 18, lines 45-53).

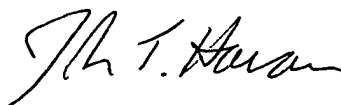
Regarding claim 28, Kilgore teaches the substrates are components of a shoe.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is **(571) 272-1217**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John T. Haran  
Examiner  
Art Unit 1733